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Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Robin Sullivan

Serial No. 76202254

Matthew J. Himich of Thompson Coburn LLP for Robin Sullivan.

Yong Oh (Richard) Kim, Trademark Examining Attorney, Law Office 115 (Tomas A. Vlcek, Managing Attorney).

Before Chapman, Grendel and Holtzman, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

On January 30, 2001, applicant filed the above-captioned application, seeking registration on the Principal Register of the mark TRAFFIC LAW CENTER (in standard character form) for services recited in the

application as "legal services."¹ Applicant asserts that TRAFFIC LAW CENTER has acquired distinctiveness and thus is registrable pursuant to Trademark Act Section 2(f), 15 U.S.C. §1052(f). The application includes applicant's claim of ownership of a prior Principal Register registration, Registration No. 2371197, which issued on July 25, 2000 and is of the mark depicted below



(TRAFFIC LAW CENTER disclaimed) for services recited in the registration as "legal services."

The Trademark Examining Attorney has issued a final refusal to register, on the ground that the designation TRAFFIC LAW CENTER is merely descriptive of applicant's recited services, and that applicant's evidence of acquired

¹ The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and March 1, 1989 is alleged in the application as the date of first use anywhere and the date of first use in commerce.

distinctiveness is not sufficient to support registration under Trademark Act Section 2(f).²

Applicant has appealed the final refusal. The appeal is fully briefed, but no oral hearing was requested.

By requesting registration under the provisions of Section 2(f) of the Trademark Act, applicant has conceded that TRAFFIC LAW CENTER is merely descriptive, i.e., that the mark lacks inherent distinctiveness and is only registrable on the Principal Register upon a showing of acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Thus, the issue in this case is whether applicant has carried his burden of establishing, by a preponderance of the evidence, that his merely descriptive mark has acquired distinctiveness. See *id.*

The record shows that applicant has used TRAFFIC LAW CENTER in connection with his legal services since 1989,

² The Trademark Examining Attorney also made final a requirement for information under Trademark Rule 2.61(b). We find that applicant has complied with the requirement by specifically stating (in his reply brief) that applicant's legal services involve the field of traffic law. Nonetheless, the better practice would have been for applicant to have specifically answered the request for information in his response to the Office action in which the request was first made by the Trademark Examining Attorney. Applicant's delay in specifically responding to the request for information resulted in this unnecessary issue having to be raised and resolved on appeal.

with services rendered to over 111,400 clients and revenues of well over twenty million dollars between 1990 and 2002. (Second Sullivan Declaration (filed August 8, 2003), at paragraphs 2 and 4.) From 1992 through June 2003, applicant spent over three million dollars to advertise and promote his services under the mark. (*Id.* at paragraph 3.)

The record includes examples of the following types of advertising and promotional materials: printouts from applicant's website; copies of applicant's advertisements in the local yellow pages (Greater St. Louis, Missouri); photographs of applicant's building signage at his multiple locations; and printouts showing applicant's local media buys, i.e., the schedules of the airing of applicant's radio and television advertising.³ Applicant also has submitted declarations from various persons who state that, inter alia, TRAFFIC LAW CENTER is "heavily advertised" in their area and that it is known as a service mark for applicant's legal services. Finally, applicant has submitted a copy of relevant pages from a licensing agreement between applicant and a third-party licensee

³ However, applicant has not submitted any examples or copy from his radio or television advertisements, so we cannot conclude that such advertising has contributed to recognition of TRAFFIC LAW CENTER as a service mark.

which, according to applicant, proves that TRAFFIC LAW CENTER has monetary value as a mark.

The Trademark Examining Attorney argues that applicant's evidence fails to establish that TRAFFIC LAW CENTER has acquired distinctiveness as a service mark because, in his advertising and promotional materials, applicant uses other designations in conjunction with TRAFFIC LAW CENTER. These include the acronym TLC, the design of a stop sign, and the designation TRAFFIC LAW CENTER OF SULLIVAN & ASSOCIATES. The Trademark Examining Attorney argues that because applicant also uses one or more of these other designations in his advertising and promotional materials, purchasers are unlikely to view TRAFFIC LAW CENTER, per se, as a service mark.

Applicant's building signage, at his multiple locations in the Greater St. Louis area, prominently displays the designation TRAFFIC LAW CENTER. Sometimes the design of a stop sign appears along with TRAFFIC LAW CENTER on these building signs, but that design does not detract from the source-indicating impact of the prominently-displayed wording TRAFFIC LAW CENTER.

Applicant's yellow pages advertisements and listings (in the "Attorneys" section of the Greater St. Louis area telephone directory), are listed alphabetically under

TRAFFIC LAW CENTER, not under TLC. Applicant's yellow pages listings sometimes, but not always, are listed under TRAFFIC LAW CENTER OF SULLIVAN & ASSOCIATES. Again, however, purchasers using the directory will find applicant's advertisements alphabetically under TRAFFIC LAW CENTER, not under SULLIVAN & ASSOCIATES. The fact that applicant uses the acronym TLC in addition to the wording for which the letters in the acronym stand, i.e., TRAFFIC LAW CENTER, does not detract from the ability of TRAFFIC LAW CENTER, per se, to function as a mark, especially when TRAFFIC LAW CENTER is used as prominently as it is in the advertisements.

Aside from his yellow pages advertising, the record shows that applicant advertises heavily in the local (St. Louis area) radio and television media. As noted above, the copy or text of such advertisements is not of record, so we cannot determine the impact such advertising would have on purchasers and prospective purchasers of applicant's services. However, applicant has submitted the declarations of three advertising sales managers from the local radio and television stations which air applicant's advertisements. In each of the declarations, the declarant avers that he is familiar with applicant and his services, that those services are rendered under the service mark

TRAFFIC LAW CENTER, and that it is that service mark which "is heavily advertised" in his station's geographic area.

Finally, applicant has submitted pertinent pages from a license agreement between applicant and another lawyer. The agreement states, inter alia, that "Sullivan [applicant] has been operating a traffic law related legal practice known as 'The Traffic Law Center,' and that "Earlywine [the other lawyer/licensee] desires to use the name 'traffic law center,' or similar name(s) and is willing to compensate Sullivan for same." The license grants to Earlywine the exclusive right to use (in a particular geographic area) the names "Traffic Law Center," "TLC," and "Traffic Law Center of Sullivan & Associates." The Trademark Examining Attorney argues that this license agreement does not prove that TRAFFIC LAW CENTER is a valid service mark, because the agreement provides a license to use marks other than TRAFFIC LAW CENTER, and the licensee could be interested only in using those other marks, i.e., "TLC" or "TRAFFIC LAW CENTER OF SULLIVAN & ASSOCIATES." We find this to be speculation on the part of the Trademark Examining Attorney. The first mark mentioned in the agreement is TRAFFIC LAW CENTER; it is just as likely that the licensee intends to use that mark primarily.

We find that the evidence discussed above suffices to establish that TRAFFIC LAW CENTER has acquired distinctiveness as a service mark for applicant's "legal services." The mark appears prominently in applicant's advertising, albeit sometimes together with subsidiary marks such as the acronym "TLC" or the more informational designation TRAFFIC LAW CENTER OF SULLIVAN & ASSOCIATES. We find that applicant's Section 2(f) evidence, especially his sales figures under the mark, the number of clients applicant has represented while using the mark, and applicant's advertisements which prominently feature the mark, is sufficient, when viewed in its entirety, to show that TRAFFIC LAW CENTER has acquired secondary meaning as applicant's service mark.

Two more matters require discussion. First, we are not persuaded by the Trademark Examining Attorney's contention that TRAFFIC LAW CENTER is a "highly descriptive" mark. The Trademark Examining Attorney bases this contention on evidence showing that there are several other lawyers or law firms around the country which use TRAFFIC LAW CENTER in rendering their services. However, each of those third-party uses is use in a proprietary manner, i.e., as a trade name or service mark, not use in a descriptive manner. These third-party proprietary usages

therefore are not evidence that applicant's mark is highly descriptive, or that it is anything more than merely descriptive. Applicant's mark is but merely descriptive, and applicant's burden under Section 2(f) therefore is not enhanced or increased as it would be if the mark were to be deemed highly descriptive.

The last matter for discussion is the genericness of the words TRAFFIC LAW. We find that although applicant's mark as a whole is registrable, the wording TRAFFIC LAW is generic for applicant's services and that the mark cannot be registered absent a disclaimer of those words. "Traffic law" is the field of law in which applicant and some other lawyers practice. The genericness of the words is established by applicant's own usage in his appeal briefs. See, e.g., page 8 of applicant's opening brief, where applicant refers to his contacts "in the field of traffic law," and at page 9, where applicant refers to attorneys "who work in the traffic law field," and his statement in footnote 1 of his reply brief that "applicant offers legal services in the field of traffic law." Likewise in the above-discussed license agreement between applicant and Earlywine, in Section 1.A. is a reference to "traffic law matters," and Section 1.C. refers to "practicing traffic law."

In short, TRAFFIC LAW is generic for applicant's legal services, and it must be disclaimed apart from the mark as shown before the mark may be registered.

Decision: Applicant's showing of acquired distinctiveness under Section 2(f) is sufficient to render applicant's mark registrable on the Principal Register, and the Trademark Examining Attorney's refusal on that ground is reversed. However, the mark will not be forwarded to publication absent submission and entry of applicant's disclaimer of the generic words TRAFFIC LAW. Applicant is allowed until thirty days from the date of this decision to submit to the Board a disclaimer, in proper form, of the words TRAFFIC LAW.⁴ Once the disclaimer is entered, the application shall proceed to publication.

⁴ The disclaimer must read "No claim is made to the exclusive right to use TRAFFIC LAW apart from the mark as shown."